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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/880,950	01/11/2002	Guennadi Eremin	4194-030270	6015

7590

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EXAMINER
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HAAS, WENDY C

ART UNIT	PAPER NUMBER
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1661

DATE MAILED: 03/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/880,950

**Applicant(s)**

EREMIN, GUENNADI

**Examiner**

Wendy C Haas

**Art Unit**

1661

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 15 June 2001.
- 2a) ☐ This action is FINAL.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☒ Claim(s) 1 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 January 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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## **DETAILED ACTION**

### **Claim Objections**

Claim 1 is objected to because of the following informalities: The claim must be directed to a PLANT. See 35 U.S.C. § 162; MPEP 1605. Appropriate correction is required. The following claim is suggested:

-- A new and distinct variety of *Prunus* plant, as herein illustrated and described. --

### **OBJECTION TO THE DISCLOSURE**

#### **37 CFR 1.163**

The following is a quotation of section (a) of 37 CFR 1.163:

*(a) The specification must contain as full and complete a disclosure as possible of the plant and the characteristics thereof that distinguish the same over related known varieties, and its antecedents, and must particularly point out where and in what manner the variety of plant has been asexually reproduced. In the case of a newly found plant, the specification must particularly point out the location and character of the area where the plant was discovered.*

#### **35 USC § 112**

The following is a quotation of the first paragraph of 35 U.S.C. 112:

*The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.*

The following is a quotation of the second paragraph of 35 U.S.C. 112:

*The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.*

As specific to United States Plant Patent applications, the specifics of 37 CFR 1.164 (reproduced below) are controlling:

*The claim shall be in formal terms to the new and distinct variety of the specified plant as described and illustrated, and may also recite the principal distinguishing characteristics. More than one claim is not permitted.*

In plant applications filed under 35 U.S.C. 161, the requirements of 35 U.S.C. are limited. The following is a quotation of 35 U.S.C. 162:

*No plant patent shall be declared invalid for noncompliance with section 112 of this title if the description is as complete as is reasonably possible. The claim in the specification shall be in formal terms to the plant shown and described.*

The disclosure is objected to under 37 CFR 1.163 (a) and under 35 U.S.C. 112, first paragraph, because the specification presents less than a full, clear and complete botanical description of the plant and the characteristics which define same per se and which distinguish the plant from related known cultivars and antecedents.

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**More specifically:**

- A. A plant color coding sheet is no longer required. Deletion of the plant color coding sheet is suggested.
- B. Applicant must insert the botanical name of the claimed plant in a separate section at the beginning of the specification following the guidelines of 37 CFR 1.163(c)(4). The proper botanical name of the claimed plant is – *Prunus cerasus* X (*P. cerasus* X *P. maakii*). Furthermore, applicant should provide the correct botanical designation for the claimed plant throughout the specification (i.e. *Prunus tomentosa* X *P. cerasifera*, *Prunus* hybrid, etc.)
- C. Page 1, lines 5-8, applicant should provide the case serial number or patent number, as appropriate, of each co-pending application listed in the cross reference section, for example: ‘VSV-1’ is United States Plant Patent Application Number 09/880,951.
- D. Page 1, lines 21-27, applicant should specify that the claimed cultivar originated as a single plant.
- E. Page 1, line 30, applicant should change the word “wide” to –wider—
- F. Page 2, line 1, applicant should insert the phrase – known to the inventor – after the word “*Prunus*”.
- G. Page 2, after line 20 applicant should insert a section describing the drawing.
- H. Page 2, lines 23-30, applicant should provide the age of the plant as described in the Detailed Description of the Variety, as well as describe the typical environmental conditions in the location of culture.
- I. Page 3, line 12, applicant states the claimed plant is moderate fruit bearing. Applicant should specify whether the plant itself bears a moderate amount of fruit or whether fruit bearing of the scion is moderate when the claimed plant is used as a rootstock. As the claimed plant’s main function is as a rootstock variety, the present recitation is unclear/confusing in this regard, especially as applicant sets forth on page 5, line 8 that the claimed plant is a low producer. Clarification of these discrepancies is needed.
- J. Page 3, line 26, applicant should replace the word “and” with –at--.
- K. Page 3, line 29, and page 4, line 9, applicant should provide the lenticel number per specified unit of area (i.e. lenticel concentration) for the lenticels appearing on the trunk and branches of the claimed plant.

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- L. Page 4, lines 1 and 10, "lens shaped" is not a botanical term of art. Clarification is required.
- M. Page 5, line 7, applicant should provide the typical and observed first and last dates of fruit maturity, if now available.
- N. Page 5, lines 30 and 31, applicant should provide the time of year (i.e. dates of first and full) the claimed plant blooms. Applicant should also specify whether the flowers of the claimed variety can function as a pollinator, if known.
- O. Applicant should indicate whether or not the blooms of the claimed plant are showy.
- P. Applicant should provide information as to the cold and heat tolerance of the claimed plant, if available.

The above listing may not be complete. Applicant should carefully compare the claimed plant with the botanical descriptions set forth in the specification to ensure completeness and accuracy and to distinguish the plant within this expanding market class. Any further botanical information should be imported into the specification, as should any additional or corrected information relative to same.

#### **CLAIM REJECTION**

#### **35 U.S.C. § 112, 1st and 2nd Paragraphs**

Claim 1 is rejected under 35 U.S.C. 112, first and second paragraphs as not being supported by a clear and complete botanical description of the plant for reasons set forth in the Objection to the Disclosure Section above.

#### **References Cited**

No references are cited.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Wendy C Haas whose telephone number is (571) 272-0976. The examiner can normally be reached on Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bruce Campbell can be reached on (571) 272-0974. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

W. C. Haas

A handwritten signature in black ink that reads "Bruce Campell". The signature is written in a cursive, flowing style.

**BRUCE R. CAMPPELL, PH.D  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1600**